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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/131,076	08/07/1998	DOUGLAS E. KLIGMAN	6149-29-U1	7303

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EXAMINER

TRAN, SUSAN T

ART UNIT PAPER NUMBER

1615

DATE MAILED: 03/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/131,076

Applicant(s)

Kligman et al.

Examiner

Susan Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jan 7, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 20-22 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11-14, and 20-22 is/are rejected.
- 7) ☒ Claim(s) 7-10 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

Receipt is acknowledged of applicants Petition for Extension of Time filed on 11/20/98, Declaration and Fee filed 02/01/99, Petition filed 02/01/99, Request for Corrected Filing Receipt filed 03/22/99, Information Disclosure Statement filed 08/07/98, Request for Extension of Time filed 1/31/00, and Preliminary Amendment A filed 1/31/00, Request for Extension of Time filed 07/26/00, 02/05/01, 05/14/01, and 01/07/02, Supplemental Information Disclosure Statement filed 09/15/00, Notice of Appeal filed 02/05/01, Request for Continued Examination filed 05/4/01, Declaration filed 05/14/01, Preliminary Amendment B filed 05/14/01, and Request for Reconsideration filed 07/26/00, 01/07/02.

### ***Claim Rejections - 35 U.S.C. § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blank, in view of Damani et al US 4,514,385.

Blank teaches a method for regulating wrinkles by topically applying to the skin a composition comprising of an effective amount of salicylic acid in ethanol solution (pages 2-4, and 6). The concentration of salicylic acid can range from 0.01% to 50% (see claim 2).

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Blank is relied upon for the reasons stated above. The reference is silent as to the teaching of salicylic acid for the treatment of acne.

Damani teaches a composition comprising from about 0.1% to about 25% salicylic acid for the treatment of acne (column 2, lines 49 through column 3, lines 1-2). Thus, it would have been prima facie obvious for one of the ordinary skill in the art to modify Blank's composition for the treatment of skin acne in view of the teaching of Damani. The reason for this modification is to obtain a composition including up to 50% salicylic acid that is safe and useful for the treatment of skin wrinkles, acne, or other skin related conditions.

1. Claims 1-6, 11, 12, and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blank. The examiner relies on the following 103(a) rejection in the case that applicant will overcome the above 102(b) rejection.

Blank is relied upon for the reasons stated above. It would have been obvious that salicylic acid at a concentration of up to 50% is safe and useful for the treatment of the skin.

#### *Claims Allowable*

2. Claims 7-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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***Response to Argument***

3. Applicant's arguments filed 01/07/02 have been fully considered but they are not persuasive. The examiner maintains the original 103(a) rejections. The 102(b) rejection has been withdrawn.

In response to applicant's arguments regarding to the piecemeal examination, applicant's previous remarks necessitated a complete review of the record, and upon the review, the reference previously supplied to the examiner was deemed to be pertinent to the issue of 103(a). The delay of the prosecution of the reference is regretted.

Applicant's arguments regarding to the rely upon the Blank references is improper are not persuasive. The recitation of newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art, see *In re Best et al.*, 195 USPQ 430 (CCPA 1977).

Applicant argues that there's no reason to combine Blank and Damani et al. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Blank and Damani et al. teaches a topical formula containing salicylic acid for the treatment of

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skin diseases. Furthermore, Damani is relied upon solely for the teaching of salicylic acid, which can be used for the treatment of acne.

Applicant argues that Damani's specific examples only showed the use of only 4% to 7.5% salicylic acid only in combination with benzoyl peroxide, it is not seen how up to 50% salicylic acid is taught by Damani et al. Contrary to the applicant's argument, first, Damani et al. is issued for the teaching within the four walls patent. Damani cannot be limited to his best mode as described in the examples. Secondly, Damani teaches between about 1% and 25% by weight of salicylic acid in his formula. Finally, applicant's claims do not exclude the use of other ingredients, e.g., benzoyl peroxide. Accordingly, it is the position of the examiner that the combination of the two references are proper.

In response to applicant's argument that applicant's intention is a one time application, while Blank and Damani applied one or more daily, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

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*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

*Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Tran whose telephone number is (703) 306-5816. The examiner can normally be reached on Monday to Thursday from 6:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
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